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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,309

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EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

09/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,309	Applicant(s) OKAMOTO ET AL.	
	Examiner ROBERT LOEWE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 12-14, 22-26, 77, 81 and 82 is/are pending in the application.
- 4a) Of the above claim(s) 4-11, 15-21 and 78-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12-14, 22-26, 77, 81 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/9/09; 8/25/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's amendments to instant claim 79 have caused claims 79 and 80 to be dependent from a withdrawn claim. As such, instant claims 79 and 80 are now considered to be withdrawn.

Applicants amendments to the instant claims have caused removal of the previously relied upon 102(b) rejections to Yamanaka (US 2002/0048680), Ooka et al. (US Pat. 4,818,790), Endo et al. (US Pat. 4,559,387), and Nanbu (US Pat. 5,639,825). Specifically, these four prior art references do not teach or suggest the employment of organic polymers having hydrolyzable silicon-containing groups which are located at the terminals of the molecular chains of the polymers.

The previously relied upon 102(b) rejection to Wakabayashi et al. (US Pat. 4,977,228) is maintained. Wakabayashi et al. is still believed to anticipate the claimed invention. Specifically, the polymers taught by Wakabayashi et al. are alkoxysilane-terminated oxyalkylene polymers. Wakabayashi et al. exemplifies a polyoxypropylene polymer having methyldimethoxysilyl end-groups. Such end groups satisfy the limitation "silicon-containing functional groups each having three or more hydrolyzable groups on one or more silicon atoms thereof". Specifically, the polymers exemplified by Wakabayashi et al. teach a total of four hydrolyzable groups on two silicon atoms. Wakabayashi et al. also suggests that polyoxyalkylenes having trialkoxy end groups may be employed.

Applicants argue that Wakabayashi et al. does not exemplify organic polymers having a trimethoxy-silyl group at the terminals and does not exemplify the addition of a silicate.

Art Unit: 1796

However, as stated above, polyoxypropylene polymers having trialkoxysilane terminal groups are not required given the language of instant claim 1. Further, Wakabayashi et al. explicitly teaches that tetra(m)ethoxysilane may be employed. Further still, Wakabayashi et al. teaches that non-tin catalysts, such as organic titanate compounds may be employed as catalysts. Such catalysts would satisfy component (E) of instant claim 1.

The 1.132 Declaration is not found to be persuasive since Wakabayashi et al. is still believed to anticipate the claimed invention. A showing of unexpected results cannot be relied upon to overcome a 102(b) rejection.

New grounds of rejection are found below. Since Applicants introduced limitations not previously presented, this Office action is final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 12-14, 22-26, 77, 81 and 82 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakabayashi et al. (US Pat. 4,977,228).

Wakabayashi et al. teaches a curable composition comprising a polyoxypropylene polymer having alkoxy groups at the terminals (which is prepared in the manner of instant claims 12, 22, and 80) (Preparation example 2). Such polymers are taught to be mixed with other silane-containing polymers along with components (C) and (D) as taught by Wakabayashi et al.

Art Unit: 1796

therein. Wakabayashi et al. explicitly teaches that ethylsilicate may be employed as component (C) (10:67). Component (D) in the examples is taught to include aminosilane coupling agents (Examples 3 and 4). Wakabayashi et al. teaches that tin carboxylate curing catalyst is preferred (11:49-59 and examples). Substitution of A-1120 of example 2 with ethylorthosilicate affords a composition satisfying the limitations of instant claim 1. Component (D) of example 2, can serve as a dehydrating agent according to Applicant's instant specification. Wakabayashi et al. further teaches that non-tin catalysts may be employed (11:49-12:34), which satisfies the limitations for component (D) of the instant claims.

Claims 1, 12-14, 22-25, 81 and 82 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujita et al. (US Pat. 5,648,427).

Claims 1, 12-14, 22-24, 81 and 82: Fujita et al. teaches a curable composition comprising an alkoxysilane-terminated polyoxyalkylene polymer and microballoons (abstract). The alkoxysilane-terminated polymers include those trialkoxysilane-terminated polymers as claimed (3:45-55).

Claim 25: Fujita et al. further teaches that aminosilanes may be added (6:7-9).

Claims 1, 12-14, 22-26, 81 and 82 are rejected under 35 U.S.C. 102(b) as being anticipated by Doi et al. (US Pat. 6,207,766).

Claims 1, 12-14, 22-24, 81 and 82: Doi et al. teaches a polyoxypropylene polymer having trimethoxysilyl end-groups (example 11-polymer P11). This polymer anticipates all of the structural limitations of component (A1) of the instant claims. Doi et al. further teaches that

Art Unit: 1796

polymer P11 is mixed with a curing catalyst which comprises a non-tin curing catalyst (dodecylamine; 17:13-22).

Claim 25: Doi et al. further teaches that aminosilane adhesion promoter may be added (11:41-49).

Claim 26: Doi et al. further teaches that a dehydrating agent may be added (13:18-32).

Relevant Art Cited

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1796

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT LOEWE whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./
Examiner, Art Unit 1796
13-Jul-09

/Randy Gulakowski/

Application/Control Number: 10/533,309

Page 7

Art Unit: 1796

Supervisory Patent Examiner, Art Unit 1796